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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

YIP, WINNIE S

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3637

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/824,206

Applicant(s)

CLARKE, DOUGAN H.

Examiner

Winnie Yip

Art Unit

3637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-41 is/are pending in the application.
- 4a) Of the above claim(s) 16, 19 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 17, 18, 20-22 and 26-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to applicant's amendment filed on May 17, 2005.

Election/Restrictions

1. Applicant's election of species in the reply filed on May 17, 2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election **without** traverse (MPEP § 818.03(a)).

Therefore, claims 16, 19, 23-25 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected specie, there being no allowable generic or linking claim.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) and 1.84(h)(4). The drawings must show every feature of the invention specified in the claims.

Therefore, the movement features of "the main and secondary hub members capable of rotating about the longitudinal axis of the pole member" (claims 14, 17), and "while permitting rotation of said main hub member about said longitudinal axis of said pole member" (claim 20) must be shown or the feature canceled from the claim. No new matter should be entered.

3. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to

prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 20-22, 26-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 and 11 of U.S. Patent No. 6,386,214 and claims 7-10 of U. S. Patent No. 6,889,699.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite substantially same structural elements such as a pole member, a main hub member, a secondary hub member, supporting structure includes ribs and struts, and pulley system including pulleys, bracket members, a pair of cams with toothed surfaces, and a line member in an alternative arrangement. Although claims of said patents do not directly claims the umbrella having ribs and strut members as claimed in the present application, an umbrella inherently having ribs and strut members, and the main hub member of said patents

is obvious being selectively positioned along the vertical pole in a predetermined position by the operation of the line member via the pulley as claimed in claims.

6. Claims 14-15 and 17-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 and 5 of U.S. Patent No. 6,889,699 and claim 21 of U.S. Patent No. 6,314,976. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both recite substantially same structural elements such as a pole member having a bolt, a main hub member, a secondary hub member having a central cavity to receive the bolt to allow the hub members being capable of rotating about the pole, supporting structure includes ribs and struts, and a pin providing means for maintaining hub member in position along the pole member in an alternative arrangement.

Claim Rejections - 35 U.S.C. § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claim 14 is rejected under 35 U.S.C. 102(b) as being anticipated by Apple (US patent No. 5,020,557).

Apple shows and discloses an umbrella frame comprising a pole member (12) having a top end and a bottom end, a top or secondary hub member (24), a main hub member (34), a plurality of rib members (20) and strut members (22) pivotally connected to the hub members to provide a means for supporting a canopy member (18) thereon, the top or secondary hub member (24) including a central cavity extending axially therethrough and having a diameter sized to receive a top end of the pole member, the hub members having bearing disk (42) for reducing friction to allow the hubs being rotatable about the longitudinal axis of the pole member, the main hub member (34) slidably mounted along the pole member, and a retaining pin (38) being placed within a retaining pin slot (40) formed on the pole member to provide means for maintaining the main hub member (34) in a vertical position along the pole member (14) to maintain the canopy in an opening position while permitting rotation of the main hub member (26) about the pole member.

9. Claims 26-32, 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent No. 628,264.

The EP reference '2634 shows and discloses an umbrella frame comprising a central pole member (6), a secondary hub member (no number), a main hub member (5), a plurality of rib members (20) and strut members (no number) pivotally connected to the hub members in the respective slots to provide a means for supporting a canopy member (21) thereon, pulley system including upper pulleys (10) secured to top of the pole member at a location between the main and secondary hub members, a bracket (4) secured to a outer surface of the main hub member (5) to support lower pulleys and a cam cleat member (13), and a line member (58) having a first end connecting the bracket members at the top surface of the main hub member and a second end (60) cooperatively engaging the pulleys and extending downwardly from the pulleys for raising and lowering the main hub member along the pole, and the cams having toothed side edges (15, 16) to selectively engage the line to maintain the main hub in a predetermined position along the pole.

9. Claims 20, 26-32, 40-41 are rejected under 35 U.S.C. 102(b) as being anticipated by European Patent No. 628,264.

The EP reference '2634 shows and discloses an umbrella frame comprising a central pole member (6), a secondary hub member (no number), a main hub member (5), a plurality of rib members (20) and strut members (no number) pivotally connected to the hub members in the respective slots to provide a means for supporting a canopy member (21) thereon, pulley system including upper pulleys (10) secured to top of the pole member at a location between the main and secondary hub members, a bracket (4) secured to a outer surface of the main hub member (5) to support lower pulleys and a cam cleat member (13), and a line member (58) having a first end connecting the bracket members at the top surface of the main hub member and a second end (60) cooperatively engaging the pulleys and extending downwardly from the pulleys for raising and lowering the main hub member along the pole, and the cams having toothed side edges (15, 16) to selectively engage the line to maintain the main hub in a predetermined position along the pole.

10. Claim 14, 20, 26-29, 31-32, and 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US patent No. 5,836,326).

Lee shows and discloses an umbrella frame comprising a central pole member (20) inherently having top and bottom ends, a top or secondary hub member (12 or 30), a main hub member (40), a plurality of rib members (55) and strut members (64) pivotally connected to the hub members to provide a means for supporting a canopy member thereon, the secondary hub member (30) including a central cavity extending axially therethrough and having a diameter sized to receive a top end of the pole member to permit rotation of the main hub member (26) about the pole member, a retaining pin (see Fig. 2) being placed within a retaining pin aperture formed on the pole member (20) bellow the main hub (40) to provide means for maintaining the main hub member (40) in a vertical position along the pole member (20) to maintain the canopy in an open position while permitting rotation of the main and secondary hub members about the pole member. Further, Lee also teaches, in another embodiment, the umbrella having pulley system including pulleys (93) secured on upper end of the pole, a line (92) around the pulley (93) and having one end fixedly mounted on the main hub member (40) and another end operatively connected with a cam cleat member (90) of a crank handle (901) bellow the main hub member for providing means for

maintaining the main hub member in predetermined position along the pole member while permitting rotation of the main hub member about the pole.

Inquiry Contacts

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 571-272-6870. The examiner can normally be reached on M-F (9:30-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 571-272-6867. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip
Primary Examiner
Art Unit 3637

wsy
July 22, 2005